*REMARKS/ARGUMENTS*

*The Pending Claims*

Claims 1-12 currently are pending. Claims 13-36 have been withdrawn pursuant to a restriction requirement. Claims 1-12 are drawn to a cosmetic composition comprising fumed alumina particles. Reconsideration of the claims is respectfully requested in view of the remarks herein.

*Discussion of the Claim Amendments*

Claims 1-12 have been amended to delete the phrase "soft-focus." This amendment is consistent with the entirety of the disclosure of the pending application. Support for these amendments also can be found at, for example, paragraphs 0001, 0004, and 0019-0022 of the specification. No new matter has been added by way of these amendments.

*Discussion of the Restriction Requirement*

Applicants acknowledge that the restriction requirement to the invention of Group I (i.e., claims 1-12) has been made final. Applicants request the rejoinder of any non-examined claims upon an indication of the allowability of any of the examined claims to the extent such non-examined claims are dependent upon, or include the limitations of, any of the allowed claims.

*Summary of the Office Action*

The Office Action sets forth the following rejections:

(a) claims 1-36 stand provisionally rejected based on statutory-type double patenting under 35 U.S.C. § 101 as allegedly claiming the same invention as that of claims 1-12, 14-25, and 27-38 of co-pending U.S. Patent Application 10/959,614, which has not yet issued;

(b) claims 1-12 stand rejected under 35 U.S.C. § 112 as allegedly indefinite for failure to particularly point out and distinctly claim the subject matter of the invention;

(c) claims 1-12 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent Application Publication 2003/0064020 (Kogoi et al.) (hereinafter "the Kogoi '020

publication") alone or in view of U.S. Patent 6,333,053 (Simon) (hereinafter "the Simon '053 patent").

*Discussion of the Double-Patenting Rejection*

Applicants acknowledge that claims 1-12 are provisionally rejected under 35 U.S.C. § 101 as allegedly claiming the same invention as that of claims 1-12, 14-25, and 27-38 of co-pending U.S. Patent Application 10/959,614. Applicants will address this rejection if and when the referenced application issues as a patent and the rejection is no longer provisional.

*Discussion of the Indefiniteness Rejection*

The Office Action rejects claims 1-12 under 35 U.S.C. § 112 as allegedly failing to particularly point out and distinctly claim the subject matter of the invention. Specifically, the Office Action alleges that the expression "soft-focus" fails to "set out the metes and bounds of the claim" and that "[r]ecourse to the specification does not define the expression." While Applicants disagree with these allegations, Applicants have deleted the term "soft-focus" from the pending claims to render the indefiniteness rejection moot and thereby further advance prosecution.

*Discussion of the Obviousness Rejection*

The Office Action rejects claims 1-12 as allegedly encompassing obvious subject matter over the Kogoi '020 publication alone or in view of the Simon '053 patent. Applicants respectfully traverse the obviousness rejection for two reasons: (1) the Kogoi '020 publication, alone or in combination with the Simon '053 publication, fails to disclose or suggest all of the limitations of the pending claims, and (2) the Office Action points to nothing that would motivate a person of ordinary skill in the art to modify or combine the cited references so as to arrive at the subject matter of the pending claims. Contrary to the Office Action's assertions, therefore, the invention defined by the pending claims is not obvious over the Kogoi '020 publication, alone or in view of the Simon '053 patent.

The Office Action relies on the Kogoi '020 publication for its disclosure of fumed alumina particles, comprising both δ and θ crystalline forms, which have an average primary particle diameter between 5 and 100 nm and an average secondary, i.e., aggregate, particle

diameter between 50 and 800 nm, and wherein alumina particles having a diameter greater than 45 μm are present in an amount of about 0.05% by weight or less. The Office Action acknowledges that the Kogoi '020 publication fails to disclose the amount of fumed alumina contained in a composition, but relies on *In re Aller*, 220 F.2d 454, 105 U.S.P.Q. 233 (C.C.P.A. 1955), for the proposition that the claimed range does not impart patentability to the claims when the general conditions of the claim are disclosed in the prior art. The Office Action essentially asserts, therefore, that the Kogoi '020 publication discloses all of the general conditions of the pending claims and thereby provides sufficient motivation for one of ordinary skill in the art to modify its disclosure to arrive at the claimed invention.

Contrary to the Office Action's assertions, however, the general conditions of the pending claims are not disclosed in the Kogoi '020 publication, and *In re Aller* is therefore inapposite. The application at issue in *In re Aller* involved a process for the treatment of organic peroxides with sulphuric acid to produce phenol and other ketone by-products. *In re Aller*, 220 F.2d at 455, 105 U.S.P.Q. at 234. In that case, the prior art disclosed "essentially the same process as that recited in the claims," the only difference being two specific reaction conditions. *Id.* In particular, the prior art disclosed a single example conducted at 100° C with 10% sulfuric acid, while applicant claimed a process temperature between 40 and 80° C with a sulfuric acid concentration between 25 and 70%. *Id.*

In the present situation, claim 1 of the pending application requires a cosmetic composition comprising about 3 wt.% or more fumed alumina particles. Pending claims 2-12 depend upon claim 1 and, therefore, incorporate all of the limitations of claim 1. The Kogoi '020 publication is directed to fumed alumina which exhibits a particular average primary and secondary, i.e., aggregate, particle diameter, as well as a process for its production (see, e.g., paragraphs 0011-0023). The Kogoi '020 publication further discloses an end-use of these fumed alumina particles in chemical-mechanical polishing ("CMP") applications (see, e.g., paragraphs 0009, 0029-0030). Specifically, the Kogoi '020 publication discloses that fumed alumina particles exhibiting these particle diameters exhibit improved abrasive properties in polishing applications, while simultaneously reducing scratching because of a reduced amount of coarse particles (see, e.g., paragraphs 0008-0009). The Kogoi '020 publication is not directed to cosmetic compositions, let alone those comprising any particular weight percent of fumed alumina. While the Kogoi '020 publication makes a

singular, generic reference to cosmetic compositions, stating that "the alumina particles can be used for not only the CMP application, but also the cosmetics application where scrubbing and smooth feeling both are desired" (paragraph 0079), nothing in the Kogoi '020 publication addresses the particular benefits provided by the use of fumed alumina, nor the use of any particular amount of fumed alumina in cosmetic compositions to achieve such benefits. Accordingly, the Kogoi '020 publication does not disclose "the general conditions" of the pending claims, and, given its focus on particle size and CMP processes, nothing in the Kogoi '020 publication would motivate a person of ordinary skill in the art to modify the disclosure of the Kogoi '020 publication to arrive at the claimed invention.

Because claim 1 of the pending application is therefore believed to be allowable over the disclosure of the Kogoi '020 publication, all claims dependent upon claim 1, i.e., pending claims 2-12, are also believed to be allowable. As such, Applicants do not separately discuss the other issues with respect to dependent claims 2-12. For example, Applicants note that the Kogoi '020 publication's disclosure that alumina particles having a diameter *greater than 45 μm*, i.e., greater than 45,000 nm, are present in an amount of about *0.05% by weight or less* indicates nothing with respect to the weight percent of fumed alumina particles that have an aggregate particle size of *300 nm or less*, an agglomerate particle size of *5 μm or more*, or an agglomerate particle size of *30 μm or less*. Contrary to the Office Action's assertion, therefore, the Kogoi '020 publication does not disclose the subject matter of pending claims 7, 10, or 11, respectively.

Because the Kogoi '020 publication does not disclose or suggest all of the elements of the pending claims, and because the Office Action has pointed to nothing to motivate one of ordinary skill in the art to modify the disclosure of the Kogoi '020 publication to arrive at the claimed invention, the pending claims cannot properly be considered obvious over the Kogoi '020 publication.

The Simon '053 patent fails to cure the deficiencies of the Kogoi '020 publication. The Office Action relies on the Simon '053 patent for its disclosure of a "cosmetic composition comprising particles of metal oxides including aluminum oxide in a preferred amount of 2 to 15%" by weight. However, the Simon '053 patent fails to disclose a cosmetic composition comprising fumed alumina, let alone fumed alumina in an amount of about 3

wt.% or more. The Simon '053 patent is directed to a particulate phase which contains specific particles defined by a mean dimension between 5 and 100 microns, and comprising at least two consecutive faces, the normals of which, at the median point, form an angle of at least 90° (see, e.g., col. 1, lines 35-67). The Simon '053 patent is directed to the shape of particles used (see, e.g., col. 1, lines 35-40), which, according to its disclosure, is preferably polyhedral (col. 1, lines 56-58). Fumed alumina, as the term is used in the pending application, refers to a form of alumina that is comprised of substantially spherical primary particles that are fused together to form irregularly-shaped aggregate particles, which may associate with one another to form even larger agglomerate particles (paragraph 0016). Although the Simon '053 patent generically discloses that metal oxides such as aluminum oxide may be used, the fumed alumina particles of the pending application do not provide the shape required by the Simon '053 patent, which discloses that "these oxides [i.e., aluminum oxide] must be cut along crystalline planes and in particular along triclinic, rhombohedral or monoclinic lattice planes but also cubic, quadratic or orthorhombic lattice planes[,] or be obtained by crystalline growth and exhibit such lattices" (col. 2, lines 35-39). The Simon '053 patent fails to disclose or suggest the use of fumed alumina whatsoever, let alone the use of about 3 wt.% or more fumed alumina particles, in a cosmetic composition.

Moreover, the Office Action does not point to anything providing the motivation that would lead a person of ordinary skill in the art to combine the cited references, which disclose the use of different types of particles in different end-use applications. As discussed above, the Kogoi '020 publication is directed to controlling the average particle diameter of fumed alumina, and on the use of these particles to produce specific advantages in CMP applications (see, e.g., paragraphs 0009, 0029-0030). The Simon '053 patent, on the other hand, while directed to the use of particles in cosmetic compositions, requires alumina with a very specific type of particulate phase that does not encompass the use of the fumed alumina particles recited in the pending claims. Therefore, there is nothing to motivate a person of ordinary skill in the art to combine the teachings of the Kogoi '020 publication with the teachings of the Simon '053 patent, let alone in the manner necessary to arrive at the present invention.

The suggestion and benefits of including about 3 wt.% or more of fumed alumina particles in a cosmetic composition are provided only by Applicants' disclosure

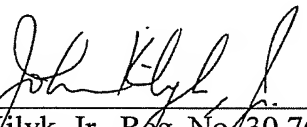
accompanying the pending claims. Therefore, to conclude that the pending claims are obvious over the combination of the Kogoi '020 publication and the Simon '053 patent is to make improper use of hindsight on viewing the disclosure accompanying the pending claims.

In view of the foregoing, the Kogoi '020 publication and the Simon '053 patent fail to teach or suggest all of the elements recited in the pending claims. Moreover, the cited references fail to provide a teaching or suggestion that would have motivated one of ordinary skill to modify or combine the cited references. For either reason, the subject matter of the pending claims cannot properly be considered obvious over the cited references, and the obviousness rejection should be withdrawn.

*Conclusion*

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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